

AF 36255

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
YOR920000552US1

In re: Application Of: Mantena et al.

Serial No.
09/752,330

Filing Date
12/29/2000

Examiner
Gart, M.

Group Art Unit
3625

Invention: **METHOD, SYSTEM AND PROGRAM PRODUCT FOR PROVIDING AN
ENTITLED PRICE IN AN ELECTRONIC TRANSACTION**

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GROUP 3600

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

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Wayne F. Reinke
Signature

Dated: January 20, 2004

Wayne F. Reinke, Esq.
Registration No. 36,650
Heslin Rothenberg Farley & Mesiti P.C.
5 Columbia Circle
Albany, New York 12203-5160

Telephone: 518-452-5600
Facsimile: 518-452-5579

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Wayne F. Reinke

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Wayne F. Reinke

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#13/ Appeal Brief
J. Ellis
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Mantena Confirmation No.: 8671
Serial No.: 09/752,330 Group Art Unit: 3625
Filed: 12/29/2000 Examiner: Gart, M.
Title: METHOD, SYSTEM AND PROGRAM PRODUCT FOR PROVIDING AN
ENTITLED PRICE IN AN ELECTRONIC TRANSACTION

CERTIFICATE OF MAILING

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Wayne F. Reinke
Wayne F. Reinke
Attorney for Appellants
Registration No.: 36,650

Date of Signature: January 20, 2004.

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Dear Sir:

APPELLANTS' APPEAL BRIEF TO THE BOARD OF
PATENT APPEALS AND INTERFERENCES

This is an appeal under 37 C.F.R. §1.191 and §1.192 from a Final Rejection, mailed on July 16, 2003, of claims 1-36, comprising all the claims finally rejected. A Notice of Appeal with a Request for One-Month Extension of Time was timely filed on November 14, 2003, and received in the U.S. Patent and Trademark Office on November 17, 2003, with an Appeal Brief

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effectively due January 20, 2004 (January 17, 2004 fell on a Saturday and Monday, January 19, 2004 was a Federal Holiday). Therefore, this Brief is being timely filed. A Transmittal of Appeal Brief is included herewith authorizing the Commissioner to charge the fee for filing this Appeal Brief in the amount of \$330 as set forth in 37 C.F.R. §1.17(f).

REAL PARTY IN INTEREST

International Business Machines Corporation, the sole assignee of the inventors' rights in this patent application, is the real party in interest.

RELATED APPEALS AND INTERFERENCES

To the knowledge of Appellants, Appellants' undersigned legal representative, or the assignee, there are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

Claims 1-36 were originally presented in the subject application. No claims were added, canceled or amended during prosecution. Claims 1-36 were finally rejected in a final Office Action with a mailing date of July 16, 2003, which was maintained in an Advisory Action with a mailing date of September 29, 2003. Therefore, claims 1-36 remain rejected and are the subject of this appeal.

STATUS OF AMENDMENTS

A Response to Final Office Action dated September 15, 2003 was filed. However, that Response contained no amendments. A Supplemental Amendment and Response to Final Office Action dated September 30, 2003 was also filed. However, that amendment merely updated serial number and filing date information for applications listed in the "Cross-Reference to Related Applications" section of the present application. An Advisory Action with a mailing date of October 22, 2003 indicated that the amendment to the specification was entered.

SUMMARY OF INVENTION

The invention comprises a method, system and program product for providing an entitled price in an electronic transaction. What comprises an entitled price is best described in the application at page 2, lines 7-16, reproduced below for convenience:

Electronic transactions involving the purchase of various goods and services have steadily increased with the popularity and use of public electronic environments, such as, for example, global computer networks (e.g., the INTERNET). Among the biggest participants in such electronic transactions are large businesses that typically make volume purchases. These types of companies tend to negotiate price discounts with one or more sellers of goods they need. Such negotiated prices are referred to herein as the "entitled price," which is the price a buyer is entitled to for a given item based on an entitlement, such as, for example, a contract with the seller or a promotional offer from the seller (e.g., a coupon) or a program with a business partner of the seller (e.g., "point" programs similar to airline mileage programs).

More specifically, the invention comprises electronically sending by a requestor (e.g., via browser 204, FIG. 2) a request for an entitled price (see above) from a public electronic environment (e.g., global computer network 210, FIG. 2). The invention further comprises automatically routing the request to a private electronic environment (e.g., private computer network 238, FIG. 2). See, e.g., page 8, lines 8-23 of the specification. The invention also comprises obtaining the entitled price within the private electronic environment while the requestor waits. See page 9, line 10 through page 10, line 27 of the application, describing an example of the request making its way through the private electronic environment (including messaging middleware 212, FIG. 2) for calculation of the entitled price by ERP application 216. In addition, the invention comprises automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor. See the specification at page 11, lines 1-16.

ISSUES

1. Whether the final Office Action improperly rejected claims 1-36 under 35 U.S.C. §102(e) as allegedly anticipated by Conklin et al. (U.S. Patent No. 6,338,050).

GROUPING OF CLAIMS

With respect to the issues on appeal recited above, Appellant believes each of the following claim sets to be separately patentable over the prior art cited in the §103 rejection thereof:

claim 1 (claims 13 and 25 stand or fall with claim 1);

claim 2 (claims 7, 9, 14, 19, 21, 26, 31 and 33 stand or fall with claim 2);

claim 3 (claims 15 and 27 stand or fall with claim 3);

claim 4 (claims 5, 16, 17, 28 and 29 stand or fall with claim 4);

claim 6 (claims 18 and 30 stand or fall with claim 6);

claim 8 (claims 20 and 32 stand or fall with claim 8); and

claim 10 (claims 11, 12, 22-24 and 34-36 stand or fall with claim 10).

ARGUMENT

Issue No. 1

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

With regard to claim 1, the final Office Action alleges on page six that “[i]n essence a catalog price is an entitled price[.]” Based on the description of an entitled price given in the present application, as set forth above in the Summary section, Appellants submit that an entitled price is clearly described in the present application as something different from the listed or catalog price. In short, Appellant has been its own lexicographer. Therefore, Appellants maintain that there is no disclosure, teaching or suggestion in Conklin et al. of the claimed

entitled price, or the claim 1 recitation of electronically sending by a requestor a request for an entitled price from a public electronic environment.

Claim 1 also recites, for example, automatically routing the request to a private electronic environment. Against this aspect of claim 1, the final Office Action at pages 2-3 cites to Conklin et al. at column 18, lines 38-47, emphasizing “private networks within a corporation.” However, the cited section mentions use of the Conklin et al. invention over the Internet or inside private networks within a corporation, the key word being “or”. In contrast, claim 1 makes clear that the request emanates from a public electronic environment and is automatically routed to a private electronic environment. In short, public-to-private (claim 1) is different from public-to-public (Conklin et al., use over the Internet) or private-to-private (Conklin et al., use within a corporate network). There is no disclosure, teaching or suggestion in Conklin et al. of a combination of public and private networks over which the request is automatically routed.

Against the above argument, the final Office Action at page 7 notes Conklin et al.’s use of the Internet, and merely alleges that “[t]hose skilled in the art appreciate it could also be a proprietary network or virtual private network, if desired.” (Emphasis in original.) Appellants submit this is mere speculation, and, in any case, is not disclosed, taught or suggested anywhere in Conklin et al. Appellants also observe that, except in very limited circumstances not applicable here, reliance on anything outside the cited reference clearly fails to present a proper anticipation rejection.

Claim 1 further recites, as another example, obtaining the entitled price within the private electronic environment while the requestor waits. Against this aspect of claim 1, the final Office Action at page 3 quotes from the Conklin et al. abstract "...allows a seller/participant to use remote authoring templates to create a complete Website for immediate integration and activation in the community, to evaluate proposed buyer orders and counteroffers, and to *negotiate* multiple variables such as price, terms, conditions, etc., iteratively with a buyer." While the final Office Action emphasizes the word "price" in the above quote, Appellants emphasize the word "negotiate" to point out that the information to determine the claimed entitled price is already known (i.e., the entitlement is already known), whereas Conklin et al. is providing a forum for the parties to agree to a price (i.e., the price is not yet known in Conklin et al. until after negotiations have ended).

Moreover, the entitled price in claim 1 is obtained from the private electronic environment while the requestor waits. The cited section of Conklin et al., i.e., the abstract, clearly does not disclose, teach or suggest obtaining a price from a private electronic environment when the request for the price comes from a public electronic environment. In addition, Conklin et al. at column 20, line 66 to column 21, line 5, makes clear that any data going into an ERP system, including price, is merely the storing of results of the negotiation after the fact, rather than first going to the ERP for the information while the requestor waits.

For all the above reasons, Appellants submit that claim 1 cannot be anticipated by or made obvious over Conklin et al.

Claim 2 recites, for example, that obtaining the entitled price comprises obtaining the entitled price from the ERP application while the requestor waits. Against this aspect of claim 2, the final Office Action cites to the Conklin et al. abstract. However, Appellants could find no disclosure, teach or suggestion in the Conklin et al. abstract of an entitled price (as defined in the present application) or an ERP application, let alone obtaining an entitled price from an ERP application while a requestor waits. The same is true for the claim 2 recitation of automatically returning the entitled price from the ERP application to the front end application for providing to the requestor.

The only mention of an ERP application Appellants could find in Conklin et al. is at column 21, lines 9 and 12. However, that entire paragraph is dedicated to discussing the use of Application Programming Interface (API) functions to translate data format. Appellants submit this has nothing whatever to do with an entitled price, obtaining one from an ERP application while the requestor waits, or automatically returning the entitled price.

Therefore, Appellants submit that claim 2 cannot be anticipated by or made obvious over Conklin et al.

Claim 3 recites that the automatically routing and the automatically returning are accomplished at least in part by messaging middleware. Against this aspect of claim 3, the final Office Action cites to Conklin et al. at column 20, line 61 through column 21, line 18. However, that section is dedicated to discussing the use of Application Programming Interface (API) functions to translate data format for use with ERP applications. Apparently, the final Office

Action equates API's with messaging middleware. However, Appellants submit that they are not the same, and one skilled in the art would appreciate the difference.

Appellants submit that an API is very purpose-specific and used by an application program to communicate with another program that provides services for it, such as an operating system. An API is implemented by adding function calls to it in the application program that is using it. In contrast, messaging middleware stands between two or more applications, providing a hub-and-spoke architecture as a central point of communications. In fact, as noted in the present application at page 9, line 14, API's can serve a role, for example, in getting the request for an entitled price to the messaging middleware from the Web server.

Claim 4 recites, in part, that the messaging middleware comprises MQSERIES. Against this aspect of claim 4, the final Office Action cites to Conklin et al. at column 20, line 61 through column 21, line 18. However, the noted section of Conklin et al. mentions only ERP systems, specifically noting ORACLE and SAP. There is no disclosure, teaching or suggestion of messaging middleware (see the argument regarding claim 3 above), let alone MQSERIES in particular. Moreover, Appellants could find no other disclosure, teaching or suggestion of messaging middleware or MQSERIES anywhere else in Conklin et al.

Therefore, Appellants submit that claim 4 cannot be anticipated by or made obvious over Conklin et al.

Claim 6 recites that the messaging middleware comprises MSMQ. Against this aspect of claim 6, the final Office Action again cites to Conklin et al. at column 20, line 61 through column 21, line 18. However, the noted section of Conklin et al. mentions only ERP systems, specifically noting ORACLE and SAP. There is no disclosure, teaching or suggestion of messaging middleware (again, see the claim 3 argument), let alone MSMQ in particular. Moreover, Appellants could find no other disclosure, teaching or suggestion of messaging middleware or MSMQ anywhere else in Conklin et al.

Therefore, Appellants submit that claim 6 cannot be anticipated by or made obvious over Conklin et al.

Claim 8 recites that the ERP application comprises BAAN. Against this aspect of claim 8, the final Office Action yet again cites to Conklin et al. at column 20, line 61 through column 21, line 18. However, while the noted section of Conklin et al. mentions ERP systems, only ORACLE and SAP are noted, not BAAN. There is no disclosure, teaching or suggestion of BAAN. Moreover, Appellants could find no other disclosure, teaching or suggestion of the BAAN ERP system anywhere else in Conklin et al.

Therefore, Appellants submit that claim 8 cannot be anticipated by or made obvious over Conklin et al.

With regard to claim 10, Appellants submit that there is no disclosure, teaching or suggestion of, for example, any of the steps recited for automatically routing. Against this aspect

of claim 10, the final Office Action again cites to Conklin et al. at column 20, line 61 through column 21, line 18. However, Appellants again submit that there is no disclosure, teaching or suggestion therein of messaging middleware, only API's. Thus, there is no disclosure, teaching or suggestion of forwarding the entitled price request from a global computer network site server to messaging middleware, or sending the request from the messaging middleware to the ERP application, as claimed in claim 10. Moreover, even if one were to assume *arguendo* that APIs are equivalent to messaging middleware (which Appellants submit they are not), Appellants submit that there certainly is no disclosure, teaching or suggestion of causing by the messaging middleware a command to be issued to the ERP application. The cited section of Conklin et al. merely speaks to data translation, with no mention of a command being issued to the ERP application.

Therefore, Appellants submit that claim 10 cannot be anticipated by or made obvious over Conklin et al.

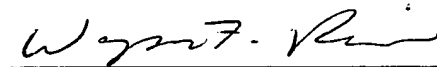
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CONCLUSION

In conclusion, Appellants submit that each of the claim sets represented by claims 1-4, 6, 8 and 10 is patentable over Conklin et al. Therefore, Appellants submit that the final Office Action should be reversed in all respects.



Wayne F. Reinke
Attorney for Appellants
Registration No.: 36,650

Dated: January 20, 2004.

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579

APPENDIX

1. (Original) A method of providing an entitled price in an electronic transaction, comprising:

electronically sending by a requestor a request for an entitled price from a public electronic environment;

automatically routing the request to a private electronic environment;

obtaining the entitled price within the private electronic environment while the requestor waits; and

automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor.

2. (Original) The method of claim 1, wherein the public electronic environment comprises a front end application, wherein the private electronic environment comprises a back end Enterprise Resource Planning (ERP) application, wherein the electronically sending comprises electronically sending by the requestor the request via the front end application, wherein the automatically routing comprises automatically routing the request to the ERP application, wherein the obtaining comprises obtaining the entitled price from the ERP application while the requestor waits, and wherein the automatically returning comprises automatically returning the entitled price from the ERP application to the front end application for providing to the requestor.

3. (Original) The method of claim 2, wherein the automatically routing and the automatically returning are accomplished at least in part by messaging middleware.
4. (Original) The method of claim 3, wherein the messaging middleware comprises MQSERIES and the ERP application comprises SAP.
5. (Original) The method of claim 3, wherein the messaging middleware comprises MQSERIES.
6. (Original) The method of claim 3, wherein the messaging middleware comprises MSMQ.
7. (Original) The method of claim 2, wherein the ERP application comprises SAP.
8. (Original) The method of claim 2, wherein the ERP application comprises BAAN.
9. (Original) The method of claim 2, wherein the public electronic environment comprises a global computer network, and wherein the front end application comprises a browser.
10. (Original) The method of claim 9, wherein the electronic transaction takes place at least partially over the global computer network, wherein the electronically sending comprises electronically sending the request from the browser to a global computer network site server, and wherein the automatically routing comprises:

forwarding the request from the global computer network site server to messaging middleware;

sending the request from the messaging middleware to the ERP application; and

causing by the messaging middleware a command to be issued to the ERP application.

11. (Original) The method of claim 10, wherein the automatically returning comprises:

sending the entitled price from the ERP application to the messaging middleware;

forwarding the entitled price from the messaging middleware to the global computer network site server; and

returning the entitled price from the global computer network site server to the browser.

12. (Original) The method of claim 11, further comprising encrypting and decrypting communications between the browser and the global computer network site server, and between the global computer network site server and the messaging middleware.

13. (Original) A system for providing an entitled price in an electronic transaction, comprising:

means for electronically sending by a requestor a request for an entitled price from a public electronic environment;

means for automatically routing the request to a private electronic environment;

means for obtaining the entitled price within the private electronic environment while the requestor waits; and

means for automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor.

14. (Original) The system of claim 13, wherein the public electronic environment comprises a front end application, wherein the private electronic environment comprises a back end Enterprise Resource Planning (ERP) application, wherein the means for electronically sending comprises means for electronically sending by the requestor the request via the front end application, wherein the means for automatically routing comprises means for automatically routing the request to the ERP application, wherein the means for obtaining comprises means for obtaining the entitled price from the ERP application while the requestor waits, and wherein the means for automatically returning comprises means for automatically returning the entitled price from the ERP application to the front end application for providing to the requestor.

15. (Original) The system of claim 14, wherein the means for automatically routing and the means for automatically returning comprise messaging middleware.

16. (Original) The system of claim 15, wherein the messaging middleware comprises MQSERIES and the ERP application comprises SAP.

17. (Original) The system of claim 15, wherein the messaging middleware comprises MQSERIES.

18. (Original) The system of claim 15, wherein the messaging middleware comprises MSMQ.

19. (Original) The system of claim 14, wherein the ERP application comprises SAP.

20. (Original) The system of claim 14, wherein the ERP application comprises BAAN.

21. (Original) The system of claim 14, wherein the public electronic environment comprises a global computer network, and wherein the front end application comprises a browser.

22. (Original) The system of claim 21, wherein the electronic transaction takes place at least partially over the global computer network, wherein the means for electronically sending comprises means for electronically sending the request from the browser to a global computer network site server, and wherein the means for automatically routing comprises:

means for forwarding the request from the global computer network site server to messaging middleware;

means for sending the request from the messaging middleware to the ERP application; and

means for causing by the messaging middleware a command to be issued to the ERP application.

23. (Original) The system of claim 22, wherein the means for automatically returning comprises:

means for sending the entitled price from the ERP application to the messaging middleware;

means for forwarding the entitled price from the messaging middleware to the global computer network site server; and

means for returning the entitled price from the global computer network site server to the browser.

24. (Original) The system of claim 23, further comprising:

means for encrypting and decrypting communications between the browser and the global computer network site server; and

means for encrypting and decrypting communications between the global computer network site server and the messaging middleware.

25. (Original) At least one program storage device readable by a machine, tangibly embodying at least one program of instructions executable by the machine to perform a method of providing an entitled price in an electronic transaction, comprising:

electronically sending by a requestor a request for an entitled price from a public electronic environment;

automatically routing the request to a private electronic environment;

obtaining the entitled price within the private electronic environment while the requestor waits; and

automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor.

26. (Original) The at least one program storage device of claim 25, wherein the public electronic environment comprises a front end application, wherein the private electronic environment comprises a back end Enterprise Resource Planning (ERP) application, wherein the electronically sending comprises electronically sending by the requestor the request via the front end application, wherein the automatically routing comprises automatically routing the request to the ERP application, wherein the obtaining comprises obtaining the entitled price from the ERP application while the requestor waits, and wherein the automatically returning comprises automatically returning the entitled price from the ERP application to the front end application for providing to the requestor.

27. (Original) The at least one program storage device of claim 25, wherein the automatically routing and the automatically returning are accomplished at least in part by messaging middleware.

28. (Original) The at least one program storage device of claim 27, wherein the messaging middleware comprises MQSERIES and the ERP application comprises SAP.

29. (Original) The at least one program storage device of claim 27, wherein the messaging middleware comprises MQSERIES.

30. (Original) The at least one program storage device of claim 27, wherein the messaging middleware comprises MSMQ.

31. (Original) The at least one program storage device of claim 25, wherein the ERP application comprises SAP.

32. (Original) The at least one program storage device of claim 25, wherein the ERP application comprises BAAN.

33. (Original) The at least one program storage device of claim 25, wherein the public electronic environment comprises a global computer network, and wherein the front end application comprises a browser.

34. (Original) The at least one program storage device of claim 33, wherein the electronic transaction takes place at least partially over the global computer network, wherein the electronically sending comprises electronically sending the request from the browser to a global computer network site server, and wherein the automatically routing comprises:

forwarding the request from the global computer network site server to messaging middleware;

sending the request from the messaging middleware to the ERP application; and

causing by the messaging middleware a command to be issued to the ERP application.

35. (Original) The at least one program storage device of claim 34, wherein the automatically returning comprises:

sending the entitled price from the ERP application to the messaging middleware;

forwarding the entitled price from the messaging middleware to the global computer network site server; and

returning the entitled price from the global computer network site server to the browser.

36. (Original) The at least one program storage device of claim 35, further comprising encrypting and decrypting communications between the browser and the global computer network site server, and between the global computer network site server and the messaging middleware.